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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,904	07/11/2001	Steven B Dunn	MBI-1064	9657

7590

11/22/2005

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary

Application No.

09/902,904

Applicant(s)

DUNN ET AL.

Examiner

Stephen Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2,4-7 and 9-49 is/are pending in the application.
- 4a) Of the above claim(s) 35-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2,4-7 and 9-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 35-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2007 09 05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2, 4-7, and 9-34, drawn to an apparatus, classified in class 34, subclass 104.
- II. Claims 35-49, drawn to a method, classified in class 34, subclass 381.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand because the independently claimed method process feature including simultaneously moving and placing at least one baby bottle are not limitations to any of the independently claimed apparatus features. It would create undue burden upon the Office to patentably distinguish these independent and distinct features between each invention and thousands of prior art references among each separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Newly submitted claims 35-49 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-49 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-7, 15-17, 22, 24-26, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Those claims recite means for imparting lateral stability, means for locking, means for frictional engaging, or frictional means. Those claim recitations are not discussed in the specification in such a

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way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The originally filed specification does not contain the terms lateral stability, locking, or friction. Any amendments made later are considered new matter and are not specified in sufficient breadth to give skilled artisans enablement for those terms. Examiner will interpret the considered non-enabling features in light of the prior art under the assumption that each feature might be enabling.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "an underlying surface," and the claim also recites "such as a counter-top" which is the narrower statement of the range/limitation.

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Regarding claim 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4-7, 15-17, 22, 24-26, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims either contain the recitation "such as" or contain terms including lateral stability, locking, or friction, which lack antecedent basis from the claims such that the claims are not indefinite. Examiner will interpret the considered indefinite features in light of the prior art under the assumption that each feature might not be indefinite.

The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Each of the claims reciting means for language is interpreted to invoke the sixth paragraph where sufficient structure, material or acts is not recited in the claims or described in the specification along with equivalents thereof.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4-7, 9, 22-26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Slipp et al. (GB 160,098). Examiner interprets the specified and/or claimed disc and disk to be patentably interchangeable, since nothing in the record shows that both uses of that term are patentably distinct. Slipp is considered to disclose the claimed invention comprising:

a tray **a** & **b** having a bottom face that is adapted to be supported by an underlying surface such as a counter-top and an upper face as expressly shown in figures 1 and 3 and expressly discussed on the first page of that reference in lines 73-78; and

a plurality of pegs **c** or **d** extending outwardly from said upper face, each of said pegs being sized and arranged so as to be able to support an article as expressly shown in figures 1-4 and expressly discussed on the first page of that reference in lines 79-80 and on the second page lines 9-10, and

wherein each of said pegs are permanently mounted to said tray in such a manner as to be movable between a first storage position wherein said entire peg is positioned adjacent to said upper face for storage and packaging of said apparatus and a second, operative position, wherein said peg is positioned so as to extend outwardly from said upper surface, so as to enable said peg to support an article, wherein said apparatus can conveniently be folded for packaging and storage purposes as expressly shown in figures 3 & 4 and expressly discussed on the first page of that reference in lines 17-28 and on the second page lines 21-26 and wherein said pegs are mounted to

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said tray in such a manner that no standing water may collect at a point where a peg is mounted, thereby minimizing potential for mold and bacterial growth as inherently disclosed on the first page lines 49-51 wherein the disclosed pegs **c** or **d** carried by bar **e** that fits within trough **a** which allows water from domestic articles is considered to anticipate the claimed tray mounted peg where no standing water collects at a peg mounted point minimizing mold/bacteria growth potential because both allow article drying by configuring pegs mounted away from any standing water; or alternatively:

a tray **a** & **b** having a bottom face that is adapted to be supported by an underlying surface and an upper face as expressly shown in figures 1 and 3 and expressly discussed on the first page of that reference in lines 73-78; and

a plurality of pegs **c** or **d** extending outwardly from said upper face, each of said pegs being sized and arranged so as to be able to support an article as expressly shown in figures 1-4 and expressly discussed on the first page of that reference in lines 79-80 and on the second page lines 9-10, and wherein

each of said pegs are permanently mounted to said tray in such a manner as to be movable between a first storage position, wherein said entire peg is positioned adjacent to said upper face for storage and packaging of said apparatus and a second, operative position, wherein said peg is positioned so as to extend outwardly from said upper surface, so as to enable said peg to support an article, wherein said apparatus can conveniently be folded for packaging and storage purposes and wherein said pegs are mounted to said tray in such a manner as to be movable only about a single axis of rotation and wherein said apparatus further comprises means for imparting lateral

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stability to said pegs, further deterring any motion other than about a single axis of rotation as expressly shown in figures 3 & 4 and expressly discussed on the first page of that reference in lines 17-28 and on the second page lines 21-26 and wherein said single axis motion for lateral stability as inherently disclosed on the first page lines 49-51 wherein the disclosed pegs **c** or **d** carried by bar **e** that fits within trough **a** which allows upward or downward peg rotation along a pivot point because both allow single axis peg rotation; or alternatively:

a tray **a** & **b** having a bottom face that is adapted to be supported by an underlying surface and an upper face as expressly shown in figures 1 and 3 and expressly discussed on the first page of that reference in lines 73-78; and

a plurality of pegs **c** or **d** extending outwardly from said upper face, each of said pegs being sized and arranged so as to be able to support an article as expressly shown in figures 1-4 and expressly discussed on the first page of that reference in lines 79-80 and on the second page lines 9-10,

disk holding means, connected to said upper face of said tray, for holding baby bottle disks in a location that is isolated from areas of said tray in which liquid may collect (this feature is interpreted to invoke the sixth paragraph of 35 USC 112 since each of the elements are considered satisfied referring to MPEP 2181 and the statement of intended use for holding is not considered to patentably distinguish the claimed invention over the prior art teachings of Slipp); and wherein

each of said pegs are permanently mounted to said tray in such a manner as to be movable between a first storage position wherein said entire peg is positioned

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adjacent to said upper face for storage and packaging of said apparatus and a second, operative position, wherein said peg is positioned so as to extend outwardly from said upper surface, so as to enable said peg to support an article, wherein said apparatus can conveniently be folded for packaging and storage purposes as expressly shown in figures 3 & 4 and expressly discussed on the first page of that reference in lines 17-28 and on the second page lines 21-26 and wherein said pegs are mounted to said tray in such a manner to allow packaging and storage as inherently disclosed on the first page lines 49-51 wherein the disclosed pegs **c** or **d** carried by bar **e** that fits within trough **a** which allows water from domestic articles is considered to anticipate the claimed tray mounted peg can be folded for the claimed intended use of packaging and storage because both allow article drying by configuring pegs upward for drying use and downward for packaging and/or storage; or alternatively:

a tray **a** & **b** having a bottom face that is adapted to be supported by an underlying surface and an upper portion as expressly shown in figures 1 and 3 and expressly discussed on the first page of that reference in lines 73-78; and

a plurality of pegs **c** or **d** extending outwardly from said upper face, each of said pegs being sized and arranged so as to be able to support a baby bottle as expressly shown in figures 1-4 and expressly discussed on the first page of that reference in lines 79-80 and on the second page lines 9-10,

mounting means for mounting said pegs to said tray so that said pegs are movable while mounted to said tray between a first storage position, wherein said entire peg is positioned adjacent to said upper face for storage and packaging of said

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apparatus and a second, operative position, wherein said peg is positioned so as to extend outwardly from said upper surface, so as to enable said peg to support an article, wherein said apparatus can conveniently be folded for packaging and storage purposes as expressly shown in figures 3 & 4 and expressly discussed on the first page of that reference in lines 17-28 and on the second page lines 21-26 and wherein said pegs are mounted to said tray in such a manner to allow packaging and storage as inherently disclosed on the first page lines 49-51 wherein the disclosed pegs **c** or **d** carried by bar **e** that fits within trough **a** which allows water from domestic articles is considered to anticipate the claimed tray mounted peg can be folded for the claimed intended use of packaging and storage because both allow article drying by configuring pegs upward for drying use and downward for packaging and/or storage; and

frictional means connected to said pegs for frictionally engaging said upper portion of said tray wherein said pegs are moved between said first storage position and said second operative position as inherently disclosed on the second page lines 17-20 since the claimed frictional means for language is not discussed in the specification in sufficient detail and wherein one skilled in the art would be able to make and/or use the claimed means for, based on the disclosed center of gravity because contact between two surfaces will axially connecting engagement thereby allowing a frictional means for the claimed intended use. Slipp is also considered to disclose the claimed means for imparting lateral stability to said pegs comprises at least one axle joining adjacent pegs together for common, ganged movement about a common axis of rotation as shown in figures 2-4, location means for locking said axle in a rotational position that corresponds

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to said second operative position as expressly disclosed on page 1 lines 35-40, and location means comprises means, connected to said axle, for frictional engaging said upper surface of said tray as inherently disclosed on the second page lines 17-20 since the claimed frictional means for language is not discussed in the specification in sufficient detail and wherein one skilled in the art would be able to make and/or use the claimed means for, based on the disclosed center of gravity because contact between two surfaces will axle connecting engagement thereby allowing a frictional means for the claimed intended use.

Claims 19-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Son (US 2,472,028).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slipp in view of Son. Slipp is considered to disclose the claimed invention, as rejected above, except for the claimed upstanding boss member that is raised from said upper face of said tray, and a plurality of disk-receiving slots defined in said boss member. Son, another apparatus for storing an article, is considered to disclose an upstanding boss member that is raised from said upper face of said tray, and a plurality of disk-receiving slots defined in said boss member in column 2 lines 30-35. It would have been obvious to one skilled in the art to combine the teachings of Slipp with the upstanding boss member that is raised from said upper face of said tray, and a plurality of disk-receiving slots defined in said boss member, considered expressly disclosed in Son, for the purpose of providing a supporting a disk portion of a baby bottle.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slipp in view of Folini (CH 685,919). Slipp is considered to disclose the claimed invention, as rejected above, except for the claimed plurality of ring support members that are constructed and arranged to support a ring portion of a baby bottle. Folini, another apparatus for storing an article, is considered to disclose a plurality of ring support members that are constructed and arranged to support a ring portion of a baby bottle at the fourth paragraph of the third translated page of that reference and as shown in figures 1 and 2. It would have been obvious to one skilled in the art to combine the teachings of Slipp with the plurality of ring support members that are constructed and arranged to support a ring portion of a baby bottle, considered expressly disclosed in Folini, for the purpose of providing a supporting a ring portion of a baby bottle.

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Claims 12-17 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slipp in view of Folini in further view of Chang (US 5,492,237). Slipp in view of Folini is considered to disclose the claimed invention, as rejected above, except for the claimed stop member ring support mount imparting lateral stability including locking means with or without a cam stop member. Chang, another apparatus for storing an article, is considered to disclose a stop member ring support mount imparting lateral stability including locking means with or without a cam stop member at column 3 line 66 through column 4 line 34. It would have been obvious to one skilled in the art to combine the teachings of Slipp in view of Folini with the stop member ring support mount imparting lateral stability including locking means with or without a cam stop member, considered expressly disclosed in Chang, for the purpose of providing a supporting an article.

Claims 18 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slipp in view of Fox (US 2,879,900). Slipp is considered to disclose the claimed invention, as rejected above, except for the claimed cutout area on a side for facilitating lifting by a user. Fox, another apparatus for storing an article, is considered to disclose a cutout area on a side for facilitating lifting by a user at column 3 lines 36-50 wherein the disclosed cutout is considered to meet the claimed cutout function because both allow a cutout region shaped to facilitate lifting. It would have been obvious to one skilled in the art to combine the teachings of Slipp with the cutout area on a side for facilitating lifting by a user, considered inherently disclosed in Fox, for the purpose of providing a lifting an article.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4-7, 9, 11, 18-19, and 32-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-15 of copending Application No. 09/904,965. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed first and second operative positions along a single axis of rotation is considered an obvious variation to the copending claimed feature of rotation axis with opposed journal holes since both describe substantially the same function means in substantially the same way with substantially the same result.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG
November 14, 2005

Stephen Gravini